

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD W. SEVIER and DOMINIC J. LOUWAGIE

Appeal No. 2001-0045
Application No. 09/103,347

ON BRIEF

Before ABRAMS, FRANKFORT, and BAHR, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-21, 24, 27 and 28. Claim 25 has been canceled and claims 22, 23 and 26 have been allowed.¹

We REVERSE AND ENTER A NEW REJECTION UNDER 37 CFR § 1.196(B).

¹In the final rejection, the examiner indicated that dependent claims 22, 23 and 26 contained allowable subject matter. Subsequently, the appellants amended them to independent form. See Papers No. 10 and 11.

BACKGROUND

The appellants' invention relates to equipment mounting racks and cabinets. An understanding of the invention can be derived from a reading of exemplary claim 1, which has been reproduced below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Anderson <u>et al.</u> (Anderson)	5,639,150	Jun. 17, 1997
Hsueh	5,664,380	Sep. 9, 1997
German Patent (Offenlegungsschrift) ² (DT 100)	26 09 100 A1	Sep. 8, 1977

Claims 1-14, 16-20, 24 and 27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Anderson.

Claims 10, 11 and 13-17 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Hsueh.

Claims 21 and 28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the German reference (DT '100).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper No. 17) for the examiner's complete reasoning in support of the rejections, and

²Our understanding of this document was obtained from a PTO translation, a copy of which is enclosed.

to the Brief (Paper No. 15) and Reply Brief (Paper No. 18) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Representative Claim 1

A rack for mounting equipment composed of a seismically sound skeleton structure having spaced vertical uprights supplemented by distinct spaced equipment mounting structures attached to said skeleton structure and extending along said vertical uprights and constituting side wall structures of a mounting rack interior space in lateral extension of said vertical uprights and including means for mounting said equipment.

The Examiner's Rejections

All of the examiner's rejections are under 35 U.S.C. § 102.³

The Rejection On The Basis Of Anderson

³Anticipation under 35 U.S.C. § 102 is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See In re Paulsen, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994). Anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference. See Verdegaal Brothers Inc. v. Union Oil Co. of California, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987), nor does it require that the reference teach what the applicant is claiming, but only that the claim on appeal "read on" something disclosed in the reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984).

Claims 1-14, 16-20, 24 and 27 stand rejected as being anticipated by Anderson.

Claim 1 recites a rack comprising a skeleton structure having spaced vertical uprights supplemented by distinct spaced equipment mounting structures attached to the skeleton structure and extending along the vertical uprights and constituting side wall structures “of a mounting rack interior space in lateral extension of said vertical uprights” (emphasis added) and including means for mounting the equipment. In arriving at the conclusion that Anderson anticipates the structure recited in the appellants’ claim 1, the examiner has found that Anderson’s “mounting channels 20” correspond to the spaced equipment mounting structures because they extend laterally, that is, “to the left” of vertical upright 12, as shown in Figure 2 (Answer, page 3). The appellants argue, however, that Anderson’s channel members 20 are not in lateral extension to the vertical uprights, “but rather . . . [are] spaced inwardly . . . from both sides of Anderson’s modular enclosure,” as opposed to the sides 31 (Brief, page 9).

We first point out with regard to this issue that “in lateral extension” is not defined in the specification and does not appear in the original claims. In the embodiment of the invention shown in Figure 1, it appears that the outer face of each equipment support structure is coplanar with the outer face of the partial enclosure surrounding the vertical upright with which it is associated. However, the appellants have not taken the position that “in lateral extension” is limited to this relationship. This being the case, we look to the common applicable definition of “lateral,” which is “coming from the side,”

and of “extension,” which is “a section forming an additional length.”⁴ Based upon these definitions, taken in the light of the description of the invention in the appellants’ specification and the arguments in the Brief, we interpret “in lateral extension of said vertical uprights” to mean that the spaced equipment mounting structures must be attached to the vertical uprights and must form additional sidewardly oriented sections of the vertical uprights.

Applying the foregoing to the rejection, we cannot agree with the examiner that element 20 of Anderson as shown in Figure 2 is “in lateral extension” of vertical upright 12 merely because it is located to the left thereof, as shown. Element 20 can be considered to be attached to vertical upright 12 through unistrut 18 and vertical strut 19. However, it appears to be located entirely inwardly of vertical upright 12, and therefore is not, in our view, “in lateral extension” of the vertical upright. This being the case, Anderson does not disclose or teach all of the subject matter recited in claim 1, and we will not sustain the rejection. It follows that we also will not sustain the like rejection of claims 2-9, which depend therefrom.

The same limitation is present in independent claims 10 and 18, and therefore we will not sustain the rejection of claims 10 and 18 or of depending claims 11-14, 16, 17, 19 and 20.

⁴See, for example, Webster’s New Collegiate Dictionary, 1973, pages 650 and 406, respectively.

Independent claim 24 is directed to an equipment rack and requires vertical uprights, a cross piece structure attached to and extending between vertical uprights and forming a corner at each of the vertical uprights, and a strut plate extending inside of the vertical upright and inside the cross piece structure in spaced relationship to the corner at an angle from a distance from that corner at the vertical upright to a distance at that corner from the cross piece structure. The examiner is of the view that this finds correspondence in the frontal vertical portion of member 16 of Anderson's Figure 4. We do not agree, for the member pointed out by the examiner extends between a side member and a cross piece structure and not between a vertical upright and a cross piece structure, as is required by the claim. The rejection of claim 24 and depending claim 27 is not sustained.

The Rejection Based Upon Hsueh

This rejection involves claims 10, 11 and 13-17.

Hsueh is directed to a frame structure for use in setting up partition walls. The structure comprises a plurality of H-shaped partition frames 1 attached together by horizontally extending upper and lower mounting plates 2 (Figure 2). Each mounting plate 2 has a vertically oriented flange 21 that is attached to the upper or lower portions of the partition frames 1.

Claim 10 recites spaced vertical uprights supplemented by distinct spaced equipment mounting structures having first sections constituting side wall structures "in

lateral extension of said vertical uprights.” As we understand the examiner’s rejection, it is based on the findings that the vertically oriented flanges constitute the claimed “spaced vertical uprights” and the center portions of the H-shaped partition frames the “lateral extensions” thereof.

We do not agree with the examiner that one of ordinary skill in the art would consider the Hsueh vertical flanges to be “spaced vertical uprights,” and we note in this regard the several exhibits offered by the appellants in support of this conclusion. Nor do we agree that the center portion of the partition frames are “in lateral extension” to the flanges, if for no other reason than they extend upwardly rather than to the side of them, and therefore do not meet the definition of “laterally.”

This rejection of independent claim 10 and dependent claims 11 and 13-17 is not sustained.

The Rejection Based Upon DT ‘100

Independent claims 21 and 28 stand rejected as being anticipated by DT ‘100, which is directed to an assembly set for forming shelving of variable size. Claim 21 sets forth a skeleton structure having spaced vertical uprights, each of which has an elongate upright partial enclosure having a main section extending in parallel to a main section of the vertical upright, first and second lateral sections extending from the main section in “spaced relationship” respectively to first and second sides of the vertical

upright, and first and second extensions extending from the lateral extensions and “engaging” respectively first and second sides of the vertical uprights.

As we understand this rejection, it is the examiner’s position that this structure reads on the G-shaped corner posts shown in Figure 3 of DT ‘100. We do not agree. First of all, the examiner is considering the stumps 6 shown extending from the upper and lower shelves in Figure 2 to be the vertical extensions recited in the claim, and the corner posts to be the partial enclosure, which in our view is not a proper reading, as we stated above with regard to similar circumstances in the rejection based upon Hsueh. Second, the rejection is defective even if the examiner’s labeling of components is accepted, for the reference does not establish that the corner posts 4, which are the elements that have the C or G-shaped cross-section (translation, page 6; Figures 3 and 4), when installed over the C-shaped stumps extending from the top and bottom shelves (Figure 2), are spaced along their lateral sides from the sides of the stumps, as is required by the claim. This being the case, the subject matter recited in the claim does not read on the reference, and the rejection of claim 21 cannot be sustained. It follows that the rejection of dependent claim 28 also is not sustainable.

New Rejection By The Board

Pursuant to our authority under 37 CFR § 1.196(b), we enter the following new rejection:

Claims 1, 2, 4, 5, 6, 10, 11, 13 and 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Anderson.

Using the language of claim 1 as a guide and with particular reference to Figure 2, Anderson discloses a rack for mounting equipment, composed of a seismically sound skeleton structure (column 1, lines 44-59; column 2, lines 59-65) having spaced vertical uprights (12) supplemented by distinct spaced equipment mounting structures (comprised of vertical unistruts 19, horizontal unistruts 18 and mounting channels 20) attached to the skeleton structure and extending along the vertical uprights (12) and constituting side wall structures of a mounting rack interior space in lateral extension of the vertical uprights (vertical unistruts 19 are attached to and extend laterally from vertical uprights 12) and including means for mounting the equipment (mounting channels 20 have holes by which equipment can be attached). Thus, all of the subject matter recited in claim 1 reads on the Anderson structure, and therefore Anderson is anticipatory thereof.

Claim 2 adds to claim 1 the requirement that the spaced equipment mounting structures are attached to the spaced vertical uprights, which is the case in Anderson, as is evident from Figure 2, where the spaced equipment mounting structures are attached to vertical uprights 12 through vertical unistrut 19.

As also is evident from Anderson's Figure 2, the spaced equipment mounting structures (19, 18 and 20) jointly constitute side wall structures of said mounting rack interior space, as is recited in claim 4.

Claim 5 augments the structure of claim 1 by reciting that the skeleton structure includes cross piece structures bracing the vertical uprights and the spaced equipment mounting structure. The cross piece structures find correspondence in cross ties 14 (Figure 3).

As for claim 6, Anderson's Figure 4 shows a base structure carrying the spaced vertical uprights and the spaced equipment mounting structures.

Independent claim 10 is directed to a rack for mounting equipment, composed of a seismically sound skeleton having spaced vertical uprights supplemented by distinct spaced equipment mounting structures, as were discussed above with regarding the new rejection of claim 1. Claim 10 further recites means for mounting the equipment and having first elongate sections (Anderson's vertical unistruts 19) extending along the spaced vertical uprights, and elongate second sections (mounting channels 20) extending along the first sections (the claim does not require that the mounting channels be directly attached to the first elongate sections) and constituting side wall structures of a mounting rack interior space in lateral extension of the vertical uprights, as was explained above with regard to the new rejection of claim 1.

As for claim 11, the elongate first sections (vertical unistruts 19) are attached to the vertical uprights (12).

Claim 13 adds to claim 10 the same structure added to claim 1 by claim 4, and the explanation provided above is applicable here.

The basic structure of independent claim 18 as it is disclosed by Anderson also was discussed above with regard to claims 1 and 10. Claim 18 recites cabinet walls attached to the skeleton structure, which are disclosed by Anderson in Figure 1. It also is clear from Figure 1 that the equipment mounting structures are inside the cabinet walls.

CONCLUSION

None of the examiner's rejections are sustained.

Pursuant to 37 CFR § 1.196(b), claims 1, 2, 4, 5, 6, 10, 11, 13 and 18 are newly rejected under 35 U.S.C. § 102(b) as being anticipated by Anderson.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
- (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED 37 CFR § 1.196(b)

NEAL E. ABRAMS
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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RETURN TO LESLEY

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APPLICATION NO. 09/103,347

APJ ABRAMS

APJ FRANKFORT

APJ BAHR

DECISION: **REVERSED; 196B**

Prepared By: LESLEY BROOKS

DRAFT TYPED: 01 Aug 03

FINAL TYPED: